

Examiner points out that Monbaliu teaches the use of conventional sources, laser or LED's for exposing silver diffusion media along with processing to form lithographic printing plates. However, Monbaliu provides no teachings or suggestion whatsoever that techniques for use in electronic screening of images to produce halftone images may be used in order to expose an imaging element. Moreover, Monbaliu neither teaches nor suggests more than "image-wise exposing an imaging element" (claim 1, col. 18, lines 3-4; description col 16, line 13).

The Examiner argues that Stoffel teaches various techniques for use in scanning and screening images such as photographs and camera images which are useful with binary output devices such as lithography, more specifically the process of error diffusion and the benefits. The Examiner further argues that "it would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel in the techniques of producing printing plates disclosed by Monbaliu, with a reasonable expectation of gaining the benefits taught by Stoffel, based upon the disclosure of Stoffel that this technique is applicable to lithography". However, the Stoffel article, which relates to non-analogous prior art, provides no motivation to apply frequency modulation halftoning to the imaging element of Monbaliu. The combining of a reference in the diffusion transfer processing and lithographic printing (Monbaliu) with a reference in the non-analogous art of electronic processing or pixel signal circuits for the reproduction of non-varying images (Stoffel) is inappropriate to an obviousness analysis under 35 U.S.C. Sec. 103.

Applicants maintain that there is little basis in the Examiner's assumption that the use of frequency modulation screening (Stoffel) in lithographic printing using a flexible support would lead to the claimed invention, with the reasonable degree of certainty or predictability.

Furthermore, the time before the current invention was made, the material disclosed in Monbaliu was used in combination with an autotypical raster, whereas in the present invention, a frequency modulation raster is used. It would be inappropriate to pick and choose references from each of the different technical fields, to reject the presently claimed invention.

In Heidelberg Druckmaschinen A.G. v. Hantscho Commercial Products, 30 U.S.P.Q.2d 1377 (Fed.Cir. 1994), a copy of which is enclosed for the Examiner's convenience, the Federal Circuit reversed the PTO's and the district court's rejection of the inventor's application for a "chopper", which was used in a web-fed rotary printing press to fold printed matter sheets as they exited from the press. The PTO had combined references in the applicant's printing press art with a reference that recited a geared double offset circle mechanism for rotary equipment -- the mechanism that the applicant had used in his chopper. The Federal Circuit reversed the rejection because the two arts were deemed non-analogous and the references provided no motivation to combine with each other.

The Heidelberg case is particularly applicable to the present invention. Here, the *lithographic* and *electronic imaging* arts are similarly non-analogous because of the differences listed above. Furthermore, Stoffel provides no motivation to use the recited error diffusion technique in lithographic printing using a flexible support. At best, there might be an invitation to try frequency modulation in the claimed invention, but this is not the

standard under 35 U.S.C. Sec. 103.

In re Geiger, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1978), a copy of which is enclosed for the Examiner's convenience, the Federal Circuit overruled a rejection similar to the one made by the Examiner in the present case. In Geiger, applicant sought to patent a method of inhibiting scale and corrosion on metallic cooling system parts by using specified compositions. The PTO had rejected the application as obvious under 35 U.S.C. Sec. 103, primarily in view of a reference that contained all of the compositions but one -- a polymer named SSMA. Other patents had discussed the use of SSMA in treating cooling water and boiler systems prone to scale formation. "Based upon the prior art and the fact that each of the three components of the composition used in the claimed method is conventionally employed in the art for treating cooling water systems, the board held that it would have been *prima facie* obvious, within the meaning of 35 U.S.C. Sec. 103, to employ these components in combination for their known functions and to optimize the amount of each additive". In re Geiger, 2 U.S.P.Q.2d at 1277-78. The applicant argued that the Examiner's rejection was based on impermissible hindsight reconstruction.

The court reversed the PTO's rejection, reasoning that an Examiner cannot combine references to establish obviousness unless the references contain some teaching suggestion or incentive to make the combination. The court stated that "[a]t best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations of these known scale and corrosion prevention agents. However, this is not the standard of 35 U.S.C. Sec. 103". *Id.* at 1278.

In re Geiger is similar to the present case. Here, the Examiner has also combined references to allegedly arrive at the method in the claimed invention. Just as in Geiger, the Examiner erred by combining the features of

one reference (Monbaliu) with another (Stoffel) without any suggestion in the references that the two should be combined. Similar to Geiger, obviousness is not established in the present case, even if a worker of ordinary skill would have found it obvious to try the frequency modulation screening of Stoffel upon the lithographic material of Monbaliu.

Because the Examiner has impermissibly combined Stoffel with Monbaliu, absent a suggestion to combine the references, and because obviousness to try is not the standard under 35 U.S.C. Sec. 103, the applicants' submit that the Examiner erred in rejecting the present invention. See also *Jones v. Hardy*, 220 U.S.P.Q. 1021, 1026 (1984) ("[T]reating the advantage as the invention ... ignores the problem-recognition element, and injects an improper 'obvious to try' consideration").

In view of the remarks herein, applicants believe that the rejections under 35 U.S.C. Sec. 103 should be withdrawn and the claimed invention is in condition for allowance. Applicants respectfully request reconsideration and allowance of now pending claims 1-7.

Also in Saikawa, there is no indication that electronic screening may be used to expose the printing plate material. The patent describes in col. 8, lines 53-58: "The photosensitive material was exposed for 10^{-5} second to the radiation beam from a neon-helium laser device... through a gray contact screen ... in close contact with the photosensitive material by means of neutral gray wedge". Further, in col. 9, lines 52-53 is said: "The lithographic printing plate obtained by use of the contact screen from the photosensitive material" (emphasis added). Therefore, there is no suggestion in Saikawa to look for electronic imaging techniques or experimentation with various screening techniques.

Also Peterson US 4,020,762, cited by the Examiner in combination with Stoffel, gives no lead to electronic screening of a continuous tone image.

Neither Stoffel, et al nor Saikawa, et al or Monbaliu et al mention the unexpected advantageous effects obtained by the method according to the current invention, i.e.:

- reducing the number of copies that have to be disposed off at the start of the printing.
- making the process less susceptible to register faults.

These specific advantages are obtained by the method according to claim 1. None of the references gives any indication that these advantages may be expected from combination of the elements according to claim 1. These references even fail to mention these advantages. Therefore, it is not obvious to include one specific method disclosed by Stoffel et al in a method for producing flexible printing plates.

It is true that Stoffel et al describes the process of error diffusion and the benefits, but these benefits are different from the above mentioned unexpected advantageous effects. As to the Office Action page 5, lines 13-14 "with a reasonable expectation of gaining the benefits taught by Stoffel et al", applicants respectfully request the Examiner to explicitly indicate in the reference the "benefits taught by Stoffel" that correspond to the advantageous effects obtained by the method according to claim 1, or which are at least indicative to prefer frequency modulation halftoning above the classic methods.

As to same page 5, line 21 "the algorithms described are compatible with lithography" is a deceptive perversion of the text: "Although lithography, xerography, etc. have different microstructural characteristics, the algo-

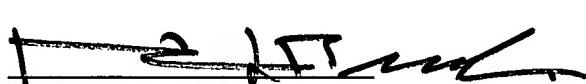
rithms investigated below are compatible in varying degree with all of them." (emphasis added). Stoffel does not concentrate on lithography alone. Selecting a frequency modulation halftoning technique is not just "some optimization to reach its full potential". Moreover, the fact that "these techniques are particularly registration sensitive", discourages the man skilled in the art to select these techniques for a printing process in which a printing plate is used that is known to be susceptible to dimensional variations as "the plate tends to enlarge somewhat until an equilibrium state is reached" (description page 3, lines 29-30).

(2) Examiner's rejection of claims 1, 4, 5 and 7 under 35 U.S.C. Sec. 103

The same arguments as above apply. Again, applicants respectfully submit that "the benefits taught by Stoffel et al" are different from the benefits obtained by the method according to the present invention, and Stoffel gives no indication of technical benefit by using frequency modulation halftoning on a lithographic printing plate precursor having a flexible support.

(3) An appropriate Terminal Disclaimer will be filed in this application.

Respectfully submitted,


Richard J. Birch
Reg. No. 20,895
Suite 125
20 William Street
Wellesley, MA 02181
617-237-1819
Attorney for Applicants

